

REMARKS

Claims 2-3, 13-20, 22-26, and 29-41 are now pending in this application. Claims 1-8, 10-11, and 13-38 are rejected. Claims 1, 4-5, 7-8, 10-11, 21, 27, and 28 are cancelled herein. Claims 6, 9, 12, are previously cancelled. New claims 39-41 are added. Claim 3 has been amended to be independent and claim 1 has been cancelled. The dependency of claim 2 has been changed from claim 1 to claim 3. Claim 13 has been amended to include the limitations of claim 21, which has been cancelled. Claim 25 has been made dependent from claim 13 instead of claim 21. Claim 26 has been amended to place it in better form in light of the amendment to claim 13.

Claims 27-28 have been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Claims 27 and 28 have been cancelled, making their rejection moot.

Claims 1, 2, 4, 5, 10-11, and 27-28 have been rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,601,959 (Brault et al.). Claims 1, 2, 4, 5, 10, 11, 27, and 28 have been cancelled, making their rejection moot.

Claims 1, 13, 29, 30, and 36 have been rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,306,374 (Hambright).

Claim 1 has been cancelled, making its rejection moot.

Regarding claim 13, Hambright discloses applying adhesive with a brush to the craft materials. Hambright fails to disclose applying any adhesive to any pattern that has been copied or printed, as recited in claim 13.

Claims 29, 30, and 36 are patentable at least for the reason that they depend from a patentable base claim. *See In re Royka and Martin*, 180 USPQ 580, 583 (CCPA 1974).

Claim 3 has been rejected under 35 U.S.C. § 103(a) as obvious over Brault et al. as applied to claim 1 and further in view of U.S. Patent No. 5,332,713 (Oldfield). To establish *aprima facie* case of obviousness, it is necessary to show that all the claim limitations are taught or suggested by the prior art. *See In re Royka and Martin*, 180 USPQ 580, 583 (CCPA 1974); MPEP § 2143.03.

Claim 3 recites "forming one or more coating layers on the transferred pattern after the transfer step is carried out." The Office Action states that forming one or more coating layers on the transferred pattern does not mean that the coating layers are in contact with the transferred pattern. Applicant disagrees with this interpretation. However, in order to expedite the prosecution of the above-identified application, Applicant has clarified claim 3 to recite that the one of the coating layers is in direct contact with the transferred pattern.

Claim 3 recites coating one or more coating layers on the transferred pattern after the transfer step is carried out, one layer being in direct contact with the transferred pattern. Brault et al. shows in Figure 12 that after the pattern is

transferred to the permanent receptor, that the topmost layer in the invention of Brault et al. is the dielectric layer and not the pattern. The dielectric layer is already in existence at the time that the transfer step occurs in Brault et al. and any subsequent coating cannot directly contact the transferred pattern disclosed in Brault et al. since the coating would be formed on the dielectric layer and not on the pattern. Accordingly, claim 3 is patentable over the cited art and notice to that effect is respectfully requested.

Claims 7 and 8 have been rejected under 35 U.S.C. § 103(a) as obvious over Brault et al. in view of U.S. Patent No. 3,716,360 (Fukushima et al.). Claims 7 and 8 have been cancelled, making their rejection moot.

Claims 13, 15-17, 31, 32, 33, 34, 35, and 36 have been rejected under 35 U.S.C. § 103(a) as obvious over Brault et al. in view of U.S. Patent No. 3,334,003 (Edwards).

The limitations of claim 21, which depends from claim 13, have been added to claim 13. Just like in claim 3 above, Applicant has clarified in claim 13 that one of the coating layers is in direct contact with the transferred pattern. Thus, claim 13 is patentable at least for the same reasons as explained above regarding claim 3.

Claims 15-17, 31, 32, 33, 34, 35, and 36 are patentable at least for the reason that they depend from a patentable base claim. *See In re Fine*, 5 USPQ2d

1596, 1600 (Fed. Cir. 1988); MPEP § 2143.03. Claims 31, 32, and 33 are additionally patentable for the reasons described below.

Regarding claim 31, the Office Action has not demonstrated that the remover layer is a sheet that is applied to the liner sheet, as recited in claim 31. The Office Action identifies layer 30 as the remover layer and Brault et al. discloses on column 8, lines 57-59 that the layer 30 is coated, which means that it is not a sheet that is applied.

Regarding claim 32, Brault et al. specifically discloses that the release layer 30 is coated and no motivation has been provided in the Office Action to spray that layer when the reference itself says otherwise. The Office Action's stated motivation to have an even coat is not sufficient to modify Brault et al. to have the release layer sprayed since the Office Action has not demonstrated that spraying the release layer provides a more uniform coverage than coating the release layer.

Regarding claim 33, Brault et al. fails to disclose or suggest sequential transferring of the designs onto the substrate.

Claim 14 has been rejected under 35 U.S.C. § 103(a) as obvious over Brault et al. in view of Edwards as applied to claim 13 and further in view of Fukushima et al. Claim 14 is patentable at least for the reason that it depends from a patentable base claim. *See In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988); MPEP § 2143.03.

Claim 18 has been rejected under 35 U.S.C. § 103(a) as obvious over Brault et al. in view of Edwards as applied to claim 13 and further in view of Sandor. Claim 18 is patentable at least for the reason that it depends from a patentable base claim. *See In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988); MPEP § 2143.03.

Claims 19 and 20 have been rejected under 35 U.S.C. § 103(a) as obvious over Brault et al. in view of Edwards as applied to claim 13 and further in view of U.S. Patent No. 5,589,434 (Takahara et al.). Claims 19 and 20 are patentable at least for the reason that they depend from a patentable base claim. *See In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988); MPEP § 2143.03.

Claim 22 has been rejected under 35 U.S.C. § 103(a) as obvious over Brault et al. in view of Edwards and Takahara et al. and further in view of U.S. Patent Pub. No. 2003/0121606 (Damico et al.). The Office Action states that Damico et al. discloses mix/applying adhesive with a brush.

Claim 22 is patentable at least for the reason that it depends from a patentable base claim. *See In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988); MPEP § 2143.03.

Damico et al. is directed to an adhesive for sheet molding compound panels. In contrast, Brault et al. is directed to the direct transfer of electrographic imaging elements. One of ordinary skill in the art would not look to Damico et al.

to modify Brault et al. because Damico et al. is directed to nonanalogous art. Thus, claim 22 is also patentable for this reason.

Claims 21 and 25 have been rejected under 35 U.S.C. § 103(a) as obvious over Brault et al. in view of Edwards as applied to claim 13 and further in view of Sandor. Claim 21 has been cancelled, making its rejection moot.

Claim 25 is patentable at least for the reason that it depends from a patentable base claim. *See In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988); MPEP § 2143.03.

Claims 23-24 have been rejected under 35 U.S.C. § 103(a) as obvious over Brault et al. in view of Edwards as applied to claim 13 and further in view of U.S. Patent No. 6,582,803 (Cole).

Claims 23 and 24 are patentable at least for the reason that they depend from a patentable base claim. *See In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988); MPEP § 2143.03.

Claim 26 has been rejected under 35 U.S.C. § 103(a) as obvious over Brault et al. in view of Edwards as applied to claim 13 and further in view of Sandor, Cole, Takahara et al., Damico et al., and Oldfield.

Claim 26 is patentable at least for the reason that it depends from a patentable base claim. *See In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988); MPEP § 2143.03.

Claim 26 recites various possibilities for the adhesive that is applied to the pattern with a brush, including some vinyl adhesives. The Office Action states that Brault et al. discloses a pressure sensitive vinyl adhesive in column 13, lines 6-9. Brault et al. discloses in column 13, lines 6-9 a pressure sensitive vinyl as the substrate to which an adhesive is added and to which the pattern is transferred. Thus, the vinyl disclosed in column 13, lines 6-9 of Brault et al. is not an adhesive that is applied to the pattern with a brush, in contrast to the recitation of claim 26. Furthermore, the Office Action has not identified the use of any of the adhesives recited in claim 26. Thus, claim 26 is patentable for these reasons as well.

Claims 37-38 have been rejected under 35 U.S.C. § 103(a) as obvious over Hambright in view of Oldfield. The Office Action states that Hambright discloses forming a pattern on a transfer sheet by copying or printing and applying an adhesive with a brush to a first surface on the pattern. To establish a *prima facie* case of obviousness, it is necessary to show that all the claim limitations are taught or suggested by the prior art. *See In re Royka and Martin*, 180 USPQ 580, 583 (CCPA 1974); MPEP § 2143.03.

Claim 37 recites forming a pattern by copying or printing and applying an adhesive with a brush to a surface of the pattern. Claim 37 also recites removing the transfer sheet after applying the pattern to the substrate. Hambright does not disclose or suggest applying adhesive to a first surface on the pattern since pattern 24 does not have any adhesive applied to it. Furthermore, the transfer sheet 28 in

Hambright is not separated from the pattern since the transfer sheet 28 is located between the pattern and the adhesive. Thus, the cited art fails to disclose or suggest all of the limitations of claim 37.

Additionally, claim 37 recite the steps as "consisting of" and therefore the step of adding craft materials in Hambright to the pressure sensitive adhesive would be excluded from the scope of claim 37. Thus, claim 37 is patentable over the cited art and notice to that effect is respectfully requested. Claim 38 is patentable at least for the reason that it depends from a patentable base claim.

New claims 39-41 have been added. Claim 39 recites providing a liner sheet, applying a remover layer in direct contact with the liner sheet, and forming a pattern in direct contact with the remover layer by copying or printing. Brault et al. fails to disclose or suggest these limitations. The Office Action states that in Brault et al. a release layer 30 can be on a carrier sheet. However, the pattern in Brault et al. is not formed directly on release layer 30 since it is formed on the dielectric layer 26.

Claim 39 recites applying an adhesive to a surface of the pattern. Hambright fails to disclose or suggest this limitation since the adhesive is not applied to the pattern. As is clear from Fig. 2 of Hambright, the adhesive 34 is applied to the transfer sheet 28.

The Office Action requests that Applicant explicitly point out where support for newly claimed features comes from. Support for newly claimed features from

the Amendment filed on June 9, 2006 and the present amendment are provided below.

Support for claims 26 and 29-41 can be found, for example, in the claims as filed and in the specification on the paragraph bridging pages 3-4, on the first and third full paragraphs of page 4, and in Figures 2, 3, 4, 5, 8, 11, 16, 17, 19, 21, and 24.

The USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,
JORDAN AND HAMBURG LLP

By C. Bruce Hamburg
C. Bruce Hamburg
Reg. No. 22,389
Attorney for Applicants

Bo and,

By Ricardo Unikel
Ricardo Unikel
Reg. No. 52,309
Attorney for Applicants

Jordan and Hamburg LLP
122 East 42nd Street
New York, New York 10168
(212) 986-2340